

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Jeffrey S. Barber et al.	Examiner:	George L. Opie
Serial No.:	09/517,366	Group Art Unit:	2194
Filed:	March 2, 2000	Docket No.:	10970975-1
Title:	System and Method for Establishing a Secure Execution Environment for a Software Process		

REPLY APPEAL BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants file this Reply Brief in response to the Examiner's Answer dated June 6, 2006.

AUTHORIZATION TO DEBIT ACCOUNT

It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's deposit account no. 08-2025.

Remarks

Appellants present the following rebuttal arguments in response to the Examiner's Answer dated June 6, 2006.

Argument 1

First, in order to establish a prima face rejection under 35 USC § 101, the law requires the Examiner to perform a specific legal analysis. In short, this analysis determines whether the rejected claims are “useful” within the meaning of § 101. Appellants reiterate that the Examiner has not analyzed the rejected claims according to the law of § 101. In other words, the Examiner has made no argument whatsoever that claims 21-30 and 38-40 are not “useful” within the meaning of 35 USC § 101. For at least these reasons, Appellants respectfully request reversal of the claim rejections.

Second, in Appellant's Appeal Brief, Appellant presents logical, coherent, and factual-based arguments as to how claims 21-30 and 38-40 are “useful.” Specifically, Appellant demonstrates that independent claim 21 has a practical application in the technological arts since the claim produces a concrete, tangible, and useful result. In light of the arguments presented in the Appeal Brief and lack of any § 101 analysis by the Examiner, Appellants respectfully request reversal of the claim rejections.

Argument 2

The Examiner's Answer argues that since the Appellants' specification includes a piece of paper within the scope of computer-readable medium, then the claims must be invalid under § 101. For several reasons, this conclusion is contrary to the law.

First, the law requires a specific legal analysis for evaluation under § 101. The Examiner has not provided this analysis. Second, the Examiner's conclusion regarding printed matter rejections is contrary to case law. As noted in Appellant's Appeal Brief, claims 21-30 and 38-40 require that information is processed, not by the mind, but by a machine. The body of independent claim 21 even recites computer elements such as “operating a software process on a computer” and “executing an operating system kernel in communication with the software process.”

Argument 3

Beginning on page 5 of the Examiner's Answer (see "(10) Response to Argument"), the Examiner makes numerous arguments. Appellants address some of these arguments below.

Part I: Examiner Has Not Applied Guidelines

The Examiner argues that recently published guidelines support the rejection of Appellant's claims (see *Interim Guidelines for Examination of patent Applications for Patent Subject Matter Eligibility* (Nov. 22, 2005), hereafter "Guidelines"). Appellants strongly argue that the Guidelines actually support the position of Appellants.

First, the Guidelines do not have the force and effect of law, but "set forth procedures USPTO personnel will follow when examining applications." The Examiner has not followed these procedures. More specifically, Annex I at the end of the Guidelines includes "a flow chart of the process USPTO personnel should follow." Appellant respectfully asks the Board of Appeals to review this flowchart. Clearly, the Examiner has not followed these procedures in examining and rejecting the claims.

Second, Appellants respectfully argue that Appellants' Appeal Brief shows how the rejected claims are (1) within an enumerated statutory category, (2) not within a judicial exception, and (3) recite a practical application that produces a useful, concrete, tangible result. This analysis is not reproduced here since it is contained in Appellants' Appeal Brief.

Part II: Rebuttal to Additional Arguments

On page 7 of the Examiner's Answer, the Examiner argues that energy does not fall within a statutory category. Appellants argue that this argument is not relevant to the pending claims.

On page 8 of the Examiner's Answer, the Examiner argues that the claims are invalid because there is an absence of hardware for electronically capturing printed subject matter into machine readable form. Method claims are not required to hardware to be valid. The Examiner is not applying the correct law.

On page 8 of the Examiner's Answer, the Examiner argues that the claims cover a piece of paper, not a process of executing the instructions with a machine. Appellants disagree. The body of independent claim 21 even recites computer elements such as "operating a software process on a computer" and "executing an operating system kernel in communication with the software process."

On page 9 of the Examiner's Answer, the Examiner argues that the recitations in claim 21 are not recited elements but "functionality," and this is not given patentable weight. Appellants disagree. Method claims, by their nature, recite functional recitations.

On pages 9-10 of the Examiner's Answer, the Examiner argues Appellants have misapplied current case law. Appellants disagree and respectfully ask the Board of Appeals to review *In re Lowry* and other cases noted in the Appeal Brief.

Respectfully submitted,

/Philip S. Lyren #40,709/

Philip S. Lyren
Reg. No. 40,709
Ph: 832-236-5529